

April 11, 2005

Case No.: AUS920010444US1 (9000/48)

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-- REMARKS --

Applicants thank the Examiner and his Supervisor for the courtesies extended in the interview of March 29, 2005.

A. Claims 17 and 18 were rejected under §112

Claims 17 and 18 have been amended to correct claim dependency, and not to avoid any reference. The amendment to claims 17 and 18 merely corrects a typographical error in the claims. Withdrawal of the §112 rejections to claims 17 and 18 is requested.

B. Claims 1-21 were rejected under 35 U.S.C. §103(a) as unpatentable over Herz in view of Jacobs

The §103(a) rejections of claims 1-21 as unpatentable over Herz in view of Jacobs is traversed. In order to maintain this rejection, each and every element of the claims must be taught or suggested, in at least as great detail as claimed, by the references, alone or in combination.

At a minimum, Herz in view of Jacobs fails to teach or suggest "providing at least one user group" as claimed in independent claims 1, 11, and 21. Contrary to the Examiner's assertion, Herz merely discloses that attributes for a single user are maintained. "[A] profile holding *that user's attributes*, including age/zip code/etc. is termed a user profile" Herz, column 4, lines 54-55 (emphasis added).

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Furthermore, Herz in view of Jacobs does not teach or suggest "determining at least one group interest for the user group" as also claimed in independent claims 1, 11, and 21. At most, Herz teaches that "the information delivery process in the preferred embodiment is based on determining the similarity between a profile for the target object and the profiles of target objects for which a user (or a similar user) has provided positive feedback in the past." See, column 6, lines 38-43. Thus, Herz does not teach determining a group interest for a *user group* – only comparing profiles for target *objects*. Indeed, by teaching that profiles of *target objects* are compared, Herz directly teaches away from determining at least one group interest for the user group.

The Examiner correctly notes that Herz fails to teach or suggest placing data objects including tag information of said group interest into a server cache, and instead relies on Jacobs for such a teaching. However, claims 1, 11, and 21 actually require "determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache." The Examiner does not even suggest that Jacobs teaches such an element.

At most, Jacobs teaches that custom data may be inserted into cached information. Jacobs does not teach relating to determining whether tag information corresponds to a group interest, and placing data objects including the tag information of said group interest into a server cache if there is correspondence.

Additionally, the Examiner's allegation of a motivation to combine falls far short of the strictures of §103(a). That Herz "gives motivation for the combination by stating users should be able to access relevant information without expending an excessive amount of time and energy" does not address the issue of whether one of ordinary skill in the art would be motivated to combine *these references* to solve that identified problem. The Examiner's formulation of the motivation illustrates the Examiner's reliance on impermissible hindsight. Even if the Examiner's allegation of Herz's teachings is correct, such a teaching does not contain any illustration of exactly how to provide a user access to relevant information without expending an excessive amount of time and energy.

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The motivation to combine references can only come from the references, be reasoned from common knowledge in the art, or from legal precedent. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01. In this case, the Examiner makes no showing that the motivation to combine the references comes from the references or that the motivation comes from legal precedent. Thus, the Examiner appears to be relying on "common knowledge in the art" – however, the Examiner makes no showing of what knowledge is common in the art, such as with official notice or an Examiner's Affidavit. As the motivation cannot come from the level of skill in the art, the Examiner needs to show *facts*, not allegations, to support that it is common knowledge in the art to combine these references. In view of the Examiner's failure to make such a showing, the §103(a) rejection must fall.

The mere fact that references *can* be combined does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01. Merely alleging that each reference teaches a salutary teaching fails to satisfy the Examiner's burden.

Neither Herz nor Jacobs overcomes the deficiencies of the other reference, such that alone or in combination, the references fail to teach or suggest each and every claim limitation, and there is no motivation to combine the references.

Applicants request withdrawal of the rejections to independent claims 1, 11, and 21, as well as claims 2-10 and 12-20 depending directly or indirectly from independent claims 1 and 11 respectively.

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SUMMARY

The Applicant respectfully submits that claims 1-21 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing amendments and remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,
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